

## **REMARKS**

### **INTRODUCTION**

In accordance with the foregoing, claims 1, 7, and 12-17 have been amended, claim 6 has been cancelled, and claim 18 has been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-5 and 7-18 are pending and under consideration. Reconsideration is respectfully requested.

### **ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116**

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because:

(a) at least certain of the rejected claims have been canceled thereby at least reducing the issues for appeal;

(b) the amendment of claims 1, 7, and 12-17 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised;

(c) the amendment of claims 1, 7, and 12-17 does not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised; and/or

(d) the Takayama and Eggelston references applied to the claims are newly cited in the final Office Action, and Applicant should be provided the opportunity to present patentability arguments and amendments in view thereof.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

### REJECTION UNDER 35 U.S.C. §103

In the Office Action at pages 2-11, numbered item 3, claims 1-4, 6, 7, 9-12, and 14-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,366,298 to Haitsuka in view of U.S. Patent No. 6,232,330 to Cohen and further in view of newly cited U.S. Patent No. 6,381,534 to Takayama. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

On page 2 of the Office Action, the Examiner acknowledged that the Amendment filed on July 20, 2004 was sufficient to overcome the Haitsuka and Cohen references.

Amended independent claim 1 recites, in relevant part, "determining a passage count of the mobile client in a predetermined advertising information transmission area in which a position indicated by the position information is located and storing the passage count, the passage count including a number of times the mobile client passes within the predetermined advertising information transmission area within a predetermined period of time" and where "when the mobile client passes through the same transmission area two or more times within the predetermined period of time, the second passage and later are not counted." Independent claim 1 has been amended to incorporate features previously found in dependent claim 6. Dependent claim 6 has been cancelled. Support for the additional feature incorporated into independent claim 1 can be found in the originally filed Specification, at least at page 23, line 24 to page 24, line 20.

In a non-limiting example, the present invention allows advertisers to effectively advertise to potential clients, because it is possible to transmit to clients and, more specifically, to vehicles driven by clients, advertisement messages that are pertinent to the area in which the client (or vehicle) is traveling. For example, the advertisements appearing in a particular neighborhood would be for stores with locations convenient to the neighborhood in which the advertisement is appearing.

The Examiner asserts that newly cited Takayama teaches the technology for transmitting an advertisement message (advertising information), the content of which is selected in relation to the number of times a client has passed through an area. Applicant respectfully disagrees. Applicant respectfully submits that Takayama describes only that a

passage count, including a number of times the mobile client passes within the predetermined advertising information transmission area, can be used to determine whether or not to send advertising information.

Applicant respectfully submits that Takayama fails to teach or suggest at least counting the number of times a mobile client passes within the predetermined advertising information transmission area within a pre-determined period of time. Further, Takayama fails to teach or suggest that, assuming that these passages repeatedly occur within a pre-assigned time period, these passages are counted as one passage only. Accordingly, Applicant respectfully submits that independent claim 1 patentably distinguishes over the prior art for at least these reasons and, therefore, is in condition for allowance. As dependent claims 2-5 and 7-11 depend, either directly or indirectly, from amended independent claim 1, Applicant respectfully submits that these claims also patentably distinguish over the prior art for at least the same reasons as independent claim 1 and, therefore, are also in condition for allowance.

As independent claims 12, and 14-17 have been amended to recite similar features to those of claim 1, Applicant respectfully submits that independent claims 12 and 14-17 patentably distinguish over the prior art for reasons similar to independent claim 1.

In the Office Action at pages 11-14, numbered item 4, claims 5 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,366,298 to Haitsuka in view of U.S. Patent No. 6,232,330 to Cohen and further in view of U.S. Patent No. 6,381,534 to Takayama and further in view of U.S. Patent No. 6,332,127 to Bandera. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Examiner cited Bandera, stating that Bandera discloses "incentives distinct from advertising. Bandera, however, fails to teach or suggest use of a passage count to determine whether or not to send advertising information.

As claim 5 depends directly from independent claim 1, Applicant respectfully submits that claim 5 patentably distinguishes over the prior art for at least the same reasons as independent claim 1.

Regarding claim 13, as asserted above, Applicant respectfully disagrees with the Examiner's position regarding Takayama. The cited portion of Takayama fails to teach or

suggest a passage count. Independent claim 13, as amended, includes similar features to claim 1. Accordingly, Applicant respectfully submits that claim 13 also patentably distinguishes over the prior art.

As Cohen, Takayama, and Bandera, taken alone or in combination, fail to teach or suggest at least counting the number of times a mobile client passes within the predetermined advertising information transmission area within a pre-determined period of time where, if the passages occur repeatedly within a pre-assigned time period, the passages are counted as one passage only. Accordingly, Applicant respectfully submits that claims 5 and 13 patentably distinguish over the prior art and are in condition for allowance.

In the Office Action at page 14, numbered item 5, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,366,298 to Haitsuka in view of U.S. Patent No. 6,232,330 to Cohen and further in view of U.S. Patent No. 6,381,534 to Takayama and further in view of U.S. Patent No. 6,360,221 to Gough. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Examiner cited Gough, stating that Gough teaches that transmission of advertising information to the client is omitted as instructed by the client. Gough, however, fails to teach or suggest maintaining a passage count.

Regarding claim 8, as discussed regarding claim 1 above, Applicant respectfully disagrees with the Examiner's position regarding Takayama. The cited portion of Takayama, quoted above, does not teach or suggest a passage count as in the present claimed invention. Accordingly, Applicant respectfully submits Haitsuka, Cohen, Takayama, and Gough, taken alone or in combination, fail to teach or suggest all of the features of the present claimed invention. Thus, Applicant respectfully submits that claim 8 also patentably distinguishes over the prior art and is in condition for allowance.

In the Office Action at page 14, numbered item 6, claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,366,298 to Haitsuka in view of U.S. Patent No. 6,232,330 to Cohen and further in view of U.S. Patent No. 6,381,534 to Takayama and further in view of newly cited U.S. Patent No. 6,061,660 to Eggelston. The reasons for the

rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Examiner cited Eggelston, stating that Eggleston discloses the utilization of award points as an incentive and related to advertising purposes. Eggleston, however, fails to teach or suggest that the passage count including a number of times the mobile client passes within the predetermined advertising information transmission area can be utilized to determine whether or not to send advertising information.

Regarding claim 17, as discussed regarding claim 1 above, Applicant respectfully disagrees with the Examiner's position regarding Takayama. As discussed with respect to amended independent claim 1, the cited portion of Takayama, fails to teach or suggest a passage count as in the present claimed invention. Accordingly, Applicant respectfully submits Haitsuka, Cohen, Takayama, and Eggelston, taken alone or in combination, fail to teach or suggest all of the features of amended independent claim 17. Thus, Applicant respectfully submits that amended independent claim 17 also patentably distinguishes over the prior art and is in condition for allowance.

#### **NEW CLAIM 18**

Claim 18 has been added to set forth the invention in varying scope. Support for new claim 18 can be found in the originally filed Specification, at least at page 24, line 21 to page 25, line 1. As claim 18 depends from amended independent claim 1, Applicant respectfully submits that claim 18 patentably distinguishes over the prior art for at least the same reasons as amended independent claim 1.

#### **CONCLUSION**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered

at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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